

REMARKS/ARGUMENTS

The Examiner has delineated the following inventions as being patentably distinct:

Group I, Claim(s) 1-14, drawn to a process for preparing benzoic esters.

Group II, Claim(s) 15-17, drawn to a composition comprising benzoic esters.

Applicants provisionally elect with traverse the invention of Group II (Claims 15-17) drawn to a composition comprising benzoic esters.

Restriction is only proper if the claims of the restriction groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are independent or patentably distinct.

The claims of Groups I and II are related as product and the process for making said product, and are considered interdependent and should be examined together on the merits, especially wherein the sole disclosed utility of the product is that disclosed in the specifications.

The claims of Group I further define the invention of Group II and the refusal to examiner the claims of Group I is a denial of substantive rights. The Examiner has failed to show, other than allege, that the claims of Group II can be made only by another method other than that recited in Group I. There is a commonality that exists between Groups I and II. It is a technical relationship that involves the same features, and it is this technical feature that defines the contribution which each of the groups taken as a whole makes over the prior art.

Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility. Composition and method for making are considered

related inventions under 37 C.F.R. § 1.475(b) and unity of invention between the groups exists.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Further, the MPEP at § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants submit that a search of all the claims would not constitute a serious burden on the Office. In fact the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that a restriction should now be required when the International Preliminary Report did not the restriction is believed to be improper. 37 C.F.R. § 1.475(b) provides in relevant part that a “national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to . . . (3) a product, process especially adapted for the manufacture of said product.” In the instant application Claims 15-17 are product claims that are being made by the process of Claims 1-14.

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants request that if the restriction of Group II is found allowable, withdrawn Group I which includes all the limitations of the allowable claims be rejoined.


Respectfully submitted,

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